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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/003,003	01/05/98	DIETZ	M 017096-00021

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QM12/1103

EXAMINER

ART UNIT PAPER NUMBER

3713

DATE MAILED:

11/03/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on filing
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1 - 30 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 - 30 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

MICHAEL O'NEILL
PRIMARY EXAMINER

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

Serial Number 09/003,003

Art Unit 3713

November 1, 1999

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 20 and 26 through 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2 and 6 through 9 of U.S. Patent No. 5,704,835. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitation of "a memory which stores *a list* of possible symbols to be displayed on said monitor" in claims 20 and 26 through 30 reads on the limitation of "a memory which stores *at least one list* of possible symbols to be displayed on said monitor" in claims 1, 2 and 6 through 9 of the '835 Patent.

Claims 2, 4, 6, 7, 13, 14, 15 and those dependent therefrom are rejected under U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Re. claims 2, 4, 6, 7 are indefinite because the phrase "can be" makes the claim unclear as to whether what follows is an existing ability or a possible ability of the claimed method. Re. claims 13, 14 and 15 are indefinite because the phrase "may be" is permissive language, i.e. use of "may" seeks permission from another.

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Claims 23 and 25 are rejected under 35 U.S.C. 112, fourth paragraph, as neither further limiting an existing limitation of the apparatus of claim 20 nor adding a new limitation to the existing limitations of the apparatus of claim 20.

5 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action :

A person shall be entitled to a patent unless - (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10 *(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.*

Claims 1 through 9 and 11 through 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dabrowski et al. The claimed method claims a method of playing
15 video poker game.

Claims 10, 18 and 19 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Manship et al. See col. 5, lines 13-28, for claim 10; col. 5, lines 35-41, and col. 7, for claims 18 and 19.

Claims 20 through 22, 24 and 26 through 30 are allowable over the prior art of record.

20 Claims 23 and 25 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112.

25 Any inquiry concerning the specifics of this communication should be directed to **Examiner Michael O'Neill**, who can be reached Monday through Thursday. Inquiries of a general nature should be directed to the Technology Center 3700 receptionist. Official responses can be filed 24 hours a day to the Official fax number listed below, subject to the provisions of 37 C.F.R. 1.6(d). Unofficial faxes which are intended to be seen by the Examiner should be sent to the Unofficial Fax number below; it is strongly suggested that the Examiner be contacted directly at the time of sending any Unofficial Fax.

Contact numbers:

30	Exr.	703-308-2656
	TC 3700 Receptionist	703-308-1148
	TC 3700 Official Fax	703-305-3579
	Unit 3713 Unofficial Fax	703-308-7768



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